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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION OF: Larry A. Christensen
SERIAL NO. : 10/668,832
FILED : September 23, 2003
TITLE : A METHOD AND MEANS FOR EXPRESSING
SPECIAL POSITIVE FEELINGS
Group/A.U. : 3611
Examiner : Brian Green
Conf. No. : 4988
Docket No. : P06486US1

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

This is an appeal from the final rejection of
claims 1-10 dated February 2, 2005.

I. Real Party In Interest:

The real party in interest of the instant appeal is
Larry A. Christensen, having an address of 708 Maple Street,
Thornton, Iowa 50479.

II. Related Appeals and Interferences:

There are no related appeals or interferences.

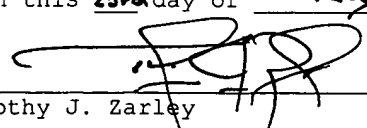
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Timothy J. Zarley

III. Status of the Claims:

Presently, claims 1-10 are pending in this application and appear as Appendix A of this brief. Claims 1-10 have all been rejected.

IV. Status of Amendments:

No amendments have been made after the final rejection of February 2, 2005.

V. Summary of Claimed Subject Matter:

Claim 1 requires a method of creating an expression of a positive feeling comprising the steps of taking an empty receptacle 10 wherein the receptacle is a package. (Page 2, lines 17-22). The next step is to place a note 18 on the package 10 that expresses the positive feelings to a recipient and request that the package 10 remain unopened. The note 18 also suggests that the unopened package is filled with the positive feelings. (Page 2, lines 20-25). These positive feelings can be identified as feelings of love and the note 18 can be a poem. (Page 2, lines 20-26). Additionally, the package 10 can have wrapping 12 that is of a gift style material. (Page 2, lines 17-20).

Also claimed is a closed container device 10 comprising a message 18 on the container 10 that expresses thoughts of special positive feelings and includes a request that the container 10 not be opened and suggests the container is filled with the special positive feelings. (Page 2, lines 17-25). This closed container 10 can have a message that is a poem or be a gift style container. (Page 2, lines 17-26). Additionally, container 10 can be covered with gift style

paper 12 and the container 10 can be an envelope. (Page 2, lines 17-19).

VI. Grounds of Rejection to be Reviewed on Appeal

The Examiner has rejected claims 1-10 under 35 U.S.C. § 103 as being unpatentable over Ledman (U.S. Pat. No. 4,194,629) in view of Kough (U.S. Pat. No. 5,568,695).

VII. Argument

A. Description of the Prior Art

1. Ledman et al. (U.S. Pat. No. 4,194,629)

Ledman discloses a love box 10 having a case 11 and a cover 12. (Col. 1, lines 44-49). The interior 14 of the box contains no physical objects, but is understood to be filled with an ethereal or spiritual love. (Col. 1, lines 49-51). A sheet 15 has a printed text 16 thereupon giving instructions to the recipient of the box. (Col. 1, lines 54-57).

In another embodiment the love box 20 has a linkage mechanism 21 so to automatically slide the card 15 inside the box when the box is opened, and slides the card outwardly when the box is closed. (Col. 1, line 58-Col. 2, line 3). Finally, in another design of a love box 30, the word "love" is printed therewithin on the bottom wall 31. (Col. 2, lines 13-17). The Ledman reference does not teach a card on top of the box nor does it teach that the card include a request that the package remain unopened and does not suggest that the unopened package is filled with positive feelings.

2. Kough (U.S. Pat. No. 5,568,695)

Kough discloses a card 10 that includes a sheet base member 12 having an outer side surface 14 and an inner side surface 16. (Col. 3, lines 14-16). Once the outer surface 14

of the card member 12 has been decorated with the designed coordinated material 50, the card member 12 is folded along line 18 so that the inner surface 16 of the first and second sections 20, 22 are facing each other, and thereby providing the inner surface of a traditional gift card. (Col. 4, lines 38-44). Once such folding has been accomplished along the direction 24, the final card 60 is formed. The inner surface 16 may be blank and be available for writing appropriate notations thereon or may be preprinted with an appropriate message. (Col. 4, lines 46-51). When one desires to secure the card 62 to the package 44 covered by wrapping paper 42, the second portion 34 of the sheet 28 can be removed so as to expose a portion of continuous and discrete adhesive material 26 thereunder. (Col. 4, lines 56-60). Adhesive material may then be utilized to attach gift cards 60 to gift 44 thereby providing a self adhering card which is coordinated with the paper 42 utilized to wrap the gift. (Col. 4, lines 60-63). Nonetheless, Kough does not teach a note that includes a request that the package remain unopened but suggests that the unopened package is filled with a positive with a positive feeling.

B. Argument In Support of Reversal

1. Rejection under 35 U.S.C. § 103

Claims 1 and 5

The Examiner has rejected claims 1-10 under 35 U.S.C. § 103 as being unpatentable over Ledman, et al. (U.S. Pat. No. 4,194,629) in view of Kough (U.S. Pat. No. 5,568,695). Appellant disagrees with the Examiner's conclusion and traverses the rejection for the following reasons. First, the Examiner has not established a prima facie case of obviousness because there is no suggestion or motivation,

either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings as suggested. Second, the Examiner has also failed to establish a prima facie case of obviousness since the prior art references do not teach or suggest all the claim limitations.

The Examiner has failed to establish that there is a suggestion or motivation to modify Ledman et al., as proposed. An obviousness analysis begins in the text of section 103 with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight when analyzing the patentability of claims pursuant to that section. See Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873, 228 USPQ 90, 98 (Fed. Cir. 1985), overruled on other grounds by Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 46 USPQ 2d 1097 (Fed. Cir. 1998). Measuring a claimed invention against the standard established requires the often difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and then-accepted wisdom in the field. See, e.g. W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher." Id.

The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine] as an essential evidentiary component of an obviousness holding") combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. See, e.g. Interconnect Planning Corp. v Feil, 774 F.2d 1132, 1138, 277 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.") In this case, the Examiner has fallen into the hindsight trap.

Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem solved, although the suggestion more often comes from the teachings of the pertinent references. Rouffet, 149 F.3d at 1355. The range of sources available does not diminish the requirement for actual evidence. That showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. e.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ 2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statement, however, are not sufficient to establish a genuine issue of material fact.").

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference or would be led in a direction divergent from the path the Appellant took. In re Gurley, 27 F.3d 551, USPQ2d. 1130, 1131 (Fed. Cir. 1991).

Appellant's independent claim 1 requires "placing a note on the package", and independent claim 5 contains a similar limitation. Conversely, Ledman, et al., teaches carving the message into the box itself, or placing it within the box (see Fig. 4 of Ledman, et al.). Appellant asserts that this teaching of Ledman, et al., to insert the message within the box teaches away from the present limitation of "placing a note on the package" so that the package may remain unopened. Thus, a person of ordinary skill in the art, upon reading the Ledman reference would be led in a direction divergent from the path the Appellant took. In view of such a teaching away, there is no motivation or suggestion to combine Ledman, et al, with Kough.

Even if the Examiner can show there is a suggestion or motivation to modify the references as suggested, the prior art references do not teach or suggest all of the claim limitations of the present invention. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See In re Vacck, 997 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP § 2143. To establish a *prima facie* case of obviousness, all the claim limitations must be taught by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All

words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 57 C.C.P.A. 1029, 1032 (1970).

Appellant's independent claim 1 recites that the note includes "A request that the package remain unopened but suggesting that the unopened package is filled with the positive feeling", and independent claim 5 recites a similar limitation. The Examiner admits that Ledman, et al., does not disclose such a step, and asserts that such a step is not a patentable feature. Appellant cannot agree. Specifically, the objects of the present invention described in the specification point out that the current invention provides a method and means for expressing positive feelings which will convey an aura of warmth and love to the recipient without opening the container in which the expression of love or other good feeling is delivered. Thus, the step of having a "request that the package remain unopened but suggesting that the unopened package is filled with the positive feeling" is an essential feature of the present invention not shown in either piece of prior art. Accordingly, Appellant asserts that independent claims 1 and 5 are not obvious in view of the proposed combination.

According to the Examiner, "Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art". (Final Office Action of Feb. 2, 2005 quoting In re Gulack, 703 F2d. 1381, 217 USPQ 401 (Fed. Cir. 1983)). However, the Federal Circuit in Gulack recognized that differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of printed matter. Id at 1385.

In Gulack the disputed claim recited three key elements: 1. A band, ring, or set of co centric rings; 2. A plurality of individual digits and printed on the band or ring at regularly spaced intervals; and 3. An algorithm by which the appropriate digits were developed. Id at 1382. According to the Federal Circuit, the difference between the appealed claims and the prior art was the number sequence of digits and in the derivation of the sequence of digits. Id. at 1387. Thus the digits themselves were functional and the Board was reversed. See id.

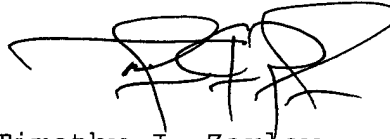
In coming to this decision, the Court discussed the case In re Miller wherein numbers that were placed on serving cups to indicate the amount of baking material within the serving cups. 57 CCPA 809, 813 (CCPA 1969); 164 USPQ 46. In Miller, the designation of these numbers provided a functional relationship and therefore the Board reversed the 103 rejection. See id.

The present situation is identical to the situations in Gulack and Miller. Specifically, the printed indicia, or note that expresses the positive feelings to a recipient and requests that the package remain unopened and suggests that the package is filled with those positive feelings, provides a functional relationship between the package and the words in that these words are what create the expression of positive feeling that is being claimed. Therefore, because the note and the message express the positive feelings that are regarded as the invention they are functional and as in Gulack and Miller, the 103 rejection should be reversed.

Dependent claims 2-4 and 6-10 are likewise not obvious due at least to their dependence on independent claims 1 and 5, respectively.

A check in the amount of \$250.00 for the Appeal Brief fee is enclosed. No other fees or extensions of time are believed to be due in connection with this response; however, consider this a request for any fee or extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'TJZ', with a large, stylized flourish extending from the end of the signature.

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TJZ/JLH/bjs

Attachment: Appendix

APPENDIX

VIII. Claims Appendix

1. (Previously amended) A method of creating an expression of a positive feeling comprising the steps of:
taking an empty receptacle, wherein the receptacle is a package, and
placing a note on the package expressing the positive feeling to a recipient of the package and including a request that the package remain unopened but suggesting that the unopened package is filled with the positive feeling.
2. (Previously amended) The method of claim 1 wherein the positive feeling is identified as being feelings of love.
3. (Original) The method of claim 1 wherein the note is a poem.
4. (Original) The method of claim 1 comprising an initial step of wrapping and enclosing the package with a gift-style material.
5. (Previously amended) A closed container device,
comprising;
a message on the container expressing thoughts of special positive feeling, and including a request that the container not be opened and suggesting that the container is filled with the special positive feeling.
6. (Original) The device of claim 5 wherein the container is a closed package.

7. (Original) The device of claim 5 wherein the message is a poem.

8. (Original) The device of claim 5 wherein the container is a gift-style container.

9. (Original) The device of claim 8 wherein the container is covered with a special gift style paper.

10. (Original) The device of claim 5 wherein the container is an envelope.

IX. Evidence Appendix

None

X. Related Proceedings Appendix

None